

#11 DAC/3743

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Inventor(s) : Masanobu SEKI
Serial Number : 09/923,413
Filed : August 8, 2001
For : TEMPERATURE CONTROL APPARATUS
Examiner : Ljiljana by V. Ciric
Group Art Unit : 3743

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OFFICE OF PETITIONS

PETITION UNDER 37 C.F.R. § 1.182 FOR
ACCEPTING LATER FILED DECLARATION AS ORIGINAL DECLARATION

The Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 2, 2004

Dear Sir:

INTRODUCTION

Applicant respectfully petitions that the executed Substitute Declaration and Power of Attorney for Patent Application, which was submitted with the response filed on July 24, 2003, be entered in this application and treated as the original the declaration for patent application.

A check in the amount of ONE HUNDRED THIRTY DOLLARS (\$130.00) for this petition as required by 37 C.F.R. § 1.17(h) is attached hereto. In the event that any additional fees are required, please charge any such fees or credit any overpayment of any Official fees to our deposit account No. 22-0256.

FACTS

The present application was filed without an executed declaration on August 8, 2001. A preliminary amendment was filed together with the application. A Notice to File Missing Parts of Application - Filing Date Granted was mailed by the Patent Office on September 13, 2001. The applicant filed a response to this notice on September 27, 2001, together with the government fee in the amount of ONE HUNDRED THIRTY DOLLARS (\$130.00) and an executed Declaration and Power of Attorney for Patent Application (hereinafter referred to as the "firstly filed declaration"). Unfortunately, the firstly filed declaration inadvertently omitted reference to the preliminary amendment filed together with the application on August 8, 2001. In order to correct this matter, applicant filed a Substitute Declaration and Power of Attorney for Patent Application (hereinafter referred to as the "substitute declaration") with the response filed on July 24, 2003. The substitute declaration identified the preliminary amendment filed together with the application on August 8, 2001, as well as the present application.

The examiner refused to accept the substitute declaration and insisted that a petition be filed authorizing entry of the substitute declaration into the application. In addition, in the final Office action mailed February 10, 2004, the examiner stated that the firstly filed declaration is defective. The examiner explained that the firstly filed declaration is defective because non-initial and/or non-dated alterations were made to the oath and declaration.

ARGUMENTS

Applicant respectfully submits that there are at least two grounds for granting this petition under 37 C.F.R. § 1.182 for accepting the substitute declaration as the original declaration in the application. Firstly, the Honorable Commissioner can direct the examiner to accept entry of the substitute declaration into the application based on the accepted practice of accepting a declaration filed after the filing of the application that identifies a preliminary amendment filed together with the application. Secondly, the Honorable Commissioner can order that the firstly filed declaration be disregarded and that the substitute declaration be used as the original declaration for the application.

The aforesaid first grounds for granting this petition find support in the Manual of Patent Examining Procedure (M.P.E.P.). Attention is respectfully directed to M.P.E.P. § 608.04(b). In the first paragraph of this section of the M.P.E.P., it is stated *that an amendment is sometimes filed along with the filing of an application and where a 37 C.F.R. § 1.53(b) application (such as the present application) is filed without a signed oath or declaration and such an application is accompanied by an amendment, that amendment is considered a part of the original disclosure* (emphasis added). This section of the M.P.E.P. continues that the subsequently filed oath or declaration must refer to both the application and the amendment. In other words, the M.P.E.P. states that the *presumption* is that an amendment filed together with the application and without a signed oath or declaration is a part of the original disclosure and that the subsequent filing of the oath or declaration must refer to both the application and the amendment is

a *formal matter*. The substitute declaration (Substitute Declaration and Power of Attorney for Patent Application) filed on July 24, 2003, referred to both the preliminary amendment filed together with the application on August 8, 2001, and the present application and, therefore, complies with the M.P.E.P. § 608.04(b).

In the alternative, applicant respectfully requests that the Honorable Commissioner order that the firstly filed declaration be disregarded and/or treated as defective and that the substitute a declaration be treated as a substitute declaration correcting any defect in the firstly filed declaration. Reasons for disregarding the firstly filed declaration or declaring the firstly filed declaration defective include that it did not refer to the preliminary amendment filed together with the application on August 8, 2001, or the reasons set forth by the examiner in the final Office action mailed February 10, 2004

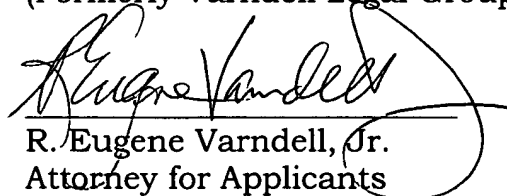
For such reasons, applicant respectfully petitions that the Honorable Commissioner direct the examiner to accept the substitute declaration in this application as the original declaration for this application.

CONCLUSION

For the foregoing reasons, applicant respectfully petitions that the Honorable Commissioner approved and order the acceptance of the Substitute Declaration and Power of Attorney for Patent Application filed on July 24, 2003, for entry into this application and, if necessary, that the Honorable Commissioner order the executed Declaration and Power of Attorney for Patent Application filed on September 27, 2001, is defective or is to be disregarded.

In the event that there are any questions in connection with this matter, it is respectfully requested that the undersigned be telephoned at the below-listed number to resolve any outstanding issues. In the case that any fees are due in connection with this petition, such fees can be charged to our deposit account No. 22-0256.

Respectfully submitted,
VARNDELL & VARNDELL, PLLC
(Formerly Varndell Legal Group)



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